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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/683,546 | 10/10/2003 | Roger Proksch | 14083-004002 | 2640 |
| 20985 | 7590 | 05/23/2005 | EXAMINER | |
| FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081 | | | LARKIN, DANIEL SEAN | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2856 | |

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/683,546

Applicant(s)

PROKSCH, ROGER

Examiner

Daniel S. Larkin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 14-21, 26, 27, and 29-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 14-21, 26, 27, and 29-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 5, 6, and 14-21 are objected to because of the following informalities:

Re claim 5, claim lines 2 and 5: The term "multi-bar" should be corrected to read -- multiple bar --.

Re claim 5, claim line 3: The term "multiple-bar" should be corrected to read -- multiple bar --.

Re claim 14, claim line 5: A -- comma -- should be inserted after the term "section".

Re claims 15-21, claim line 1: The term "apparatus" should be corrected to read -- assembly --. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 14-21 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 14, claim line 6: The phrase "said measuring device" lacks antecedent basis.

Re claim 14, claim lines 6 and 7: Is this recitation of a "movable bar assembly" the same structure as the multiple bar linkage recited in claim 1? The specification,

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page 17, lines 13-22, discloses that a steering mechanism 122 includes a movable bar assembly having a coupling bar or a first link 130 and a second link 134 (multiple linkage bar), wherein one link is coupled to a reference structure and the other link is coupled to an actuator.

Re claim 14, claim lines 9 and 11: The phrases "said beam" and "said deflected beam" lack antecedent basis.

Re claim 15, claim lines 2-6: Is this recitation of a "first link" and a "second link" the same link structure of the multiple bar linkage recited in claim 1?

Re claim 17, claim line 2: The phrase "said light beam" lacks antecedent basis.

Re claim 20, claim lines 1-4. Is this recitation of the link the same as the recitation of the links and coupling previously recited in claim 1?

Re claim 27, claim line 4: The phrases "said reflecting surface" lacks antecedent basis.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 7 and 8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12, 18, and 19 of U.S. Patent No. 6,530,268. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent are narrower in scope than the limitations cited in the application claims. Therefore, the patent claims teach all of the limitations of the application claims plus additional limitations not found in the application claims.

6. Claims 7 and 29-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16 and 43-46 of U.S. Patent No. 6,612,160. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Claim 15 of the patent is narrower in scope than the limitations cited in application claim 7. Therefore, the patent claim teaches all of the limitations of the application claim plus additional limitations not found in the application claims.

Claims 43-46 of the patent are narrower in scope than the limitations cited in application claims 29-32. Therefore, the patent claims teach all of the limitations of the application claims plus additional limitations not found in the application claims.

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7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claims 1-6, 8, 26, and 27 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 10-15, 17, 40, and 41 of prior U.S. Patent No. 6,612,160.

This is a double patenting rejection.

Patent claims 10-15 and 17 correspond to the limitations recited in application claims 1-6 and 8.

Patent claims 40 and 41 correspond to the limitations recited in application claims 26 and 27.

Response to Arguments

9. Applicant's arguments with respect to claims 1-8, 14-21, 26, 27, and 29-32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Larkin whose telephone number is 571-272-2198. The examiner can normally be reached on 8:00 AM - 5:00 PM Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams can be reached on 571-272-2208. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Larkin
AU 2856
10 May 2005


DANIEL S. LARKIN
PRIMARY EXAMINER